

Remarks

Section 103

In the next sections a number of claims were rejected by the Examiner as rendered obvious by one or more prior art references. In making an obviousness rejection, the Examiner must first determine the scope and content of the prior art, ascertain the differences between the prior art and the claims in issue, and resolve the level of ordinary skill in the art. Graham v. John Deere 148 USPQ 459 (1966). In order to establish a *prima facie* case of obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. In re Royka, 180 USPQ 580 (CCPA 1974). The present claims, as currently amended, are not obvious under this standard.

Claims 1-14, 17-18, 21, 24-26, 28, 30, and 31 were rejected as rendered obvious by Buermann (U.S. Patent No. 6,003,714) in view of Petryna (U.S. Patent No. 6,247,491) in further view of Oliver (U.S. Patent No. 4,266,813). A review of these references will demonstrate that these references, singly or in combination, fail to teach every claimed element.

In the Office action, Buermann is cited as teaching "a tamper notification and protection device . . . for blocking particles from entering the first fitting" (Office action, page 2), including "first and second straps (2 and 3) bendable about the valve" (Office action, page 2), and a means for fastening the first and second strap together.

However the Office action notes "Buermann fails to disclose a tapered cylinder having a base and inner and outer surfaces with securing means." (Office action, page 3.) The missing claimed feature is asserted in the Office action to be found in Oliver, which discloses according to the Office action a "tapered cylinder having an inner and outer surfaces with securing means." (Office action, page 3.)

Independent claims 1, 17, and 30 have all been amended to make the difference between the claimed tapered cylinder feature and the elements of the cited references even more apparent. In claim 1, this feature now requires "a tapered cylinder having an inner tapered surface and an outer tapered surface each having a securing means on said inner tapered surface and said outer tapered surface, said securing means configured to allow mounting onto a valve fitting." In claim 17, this feature now requires "a tapered cylinder having an inner and outer tapered surfaces configured to secure the cylinder onto a valve fitting." Amended claim 30 presently requires "a tapered cylinder having a first end and a second end, the second end including an inner tapered surface having a securing means, and an outer tapered surface having a securing means, said tapered cylinder attachable to valve fittings of various sizes by using one of either said securing means of said inner surface or securing means of said outer surface."

Each of the three claims specifies that the tapered cylinder must have a tapered inner surface and a tapered outer surface. Furthermore, each of these claims requires that both the inner and outer tapered surface include a feature to attach to valve fittings.

Oliver does not teach the above noted claim elements. To the contrary, Oliver teaches away from adopting these features. Oliver does not teach a tapered cylinder but instead illustrates a "funnel shaped device" (See Abstract) that is "adapted to selectively engage male or female standard garden hose fittings, antifreeze bottles" and other bottles, such as bleach bottles. The inner surface is not tapered, as claimed by the Applicant. To the contrary, the inner surface is designed to allow threading onto different width bottle or hose fittings, as noted above. A tapered surface would not engage the bottle opening. This effectively teaches away from

adopting the claimed structure. The structure disclosed by Oliver is an interior surface that is a number of stacked, threaded cylindrical openings. To function and receive male threaded features the openings in Oliver could not be tapered. In addition, the one and only tapered surface in Oliver, an exterior surface, does not include an attachment for a fitting. Indeed, it could not without, as noted, preventing attachment of a threaded coupling as the Oliver device requires.

In contrast, the Applicant has claimed that both the inner surface and the outer surface have an element to securing the surface to valve fittings. As claimed, the securing means configured to allow mounting onto a valve fitting is required to be on a tapered surface. Oliver does not teach this element, and in fact Oliver teaches away from adopting this element. Given that at least one element is not taught in the cited references, the present rejection must be reconsidered and withdrawn.

With respect to the dependent claims, claims 4, 10-12, 14, 15, 18, 20, 22-26, 29, and 31-32 have been canceled. All of the remaining dependent claims 2, 3, 5-9, 13, 16, 21, 27, and 28 depend on independent claims 1 and 17. These independent claims have been shown to be not rendered obvious by the cited references. The dependent claims should be found to be not obvious for at least the same reasons as the independent claims.

Neither Buermann, nor Petryna, nor Oliver teach what the Applicant has currently included in the independent claims, namely a tapered cylinder having a tapered inner surface and a tapered outer surface configured such that a valve could be mounted on either the inner surface or the outer surface. Given this fact these claims should be allowable.

In section 4 of the Office action, claims 16, 19-20, 27, and 32 were rejected as rendered obvious by Buermann in

view of Petryna and Oliver in further view of Robbins et al (U.S. Patent No. 6,783,031) ["Robbins" hereafter]. Claims 19-20, and 32 have been canceled. As noted above, the combination of Buermann, Petryna, and Oliver do not teach the limitations of the independent claims 1, 17, and 30. Robbins, cited as teaching that threads and tangs are interchangeable, fails to remedy this deficiency. Given this fact, the newly cited reference in combination with the three earlier cited references, does not render obvious the Applicant's independent claims and thus also cannot render obvious Applicant's claims 16 (dependent on claim 1), claim 27 (dependent on claim 17), and claim 32 (dependent on claim 32).

No Proper Cited Teaching to Combine

In addition to the above reasoning obviating the obviousness finding, this rejection also does not have a proper teaching to combine the references. One of the basic requirements of a prima facie case of obviousness is that some teaching to combine the references must be preferred. See MPEP § 2143. In the recent KSR Int'l Co. v. Teleflex Inc. decision, the Supreme Court found:

a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the art. Although common sense directs one to look with care at a patent application that claims as innovation the combination of two known devices according to their established functions, it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combining the elements in the way the claimed new invention does. 127 S. Ct. 1727(2007), 82 USPQ2d, 1397.

The Federal Circuit has set out a number of useful guidelines for determining when there is no teaching to combine. If a proposed modification would render the prior art invention being modified unsatisfactory for its intended

purpose, then there is no suggestion or motivation to make the proposed modification. See MPEP § 2143.01 (v), In re Gordon,

221 USPQ 1125 (Fed. Cir. 1984). The Federal Circuit has also established that if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the reference are not sufficient to render the claims obvious. In re Ratti, 123 USPQ 349 (CCPA 1959).

In the present instance the Office action finds: "Petyna discloses a tapered cylinder (See Figure 9). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have provided a tapered cylinder in order to receive the valve as taught by Petryna (abstract)." (Office action, page 3.)

The law states that a combination of references cannot properly be combined if the combination would render the reference unfit for its intended purpose. The proposed combination would require that Petyna have a tapered inner and outer surface. However such a structure would not be able to receive threads from a hose, bleach bottle, or other bottle, which is the very purpose of the Petyna device. Petyna not only does not allow for this combination, but the required structure of Petyna effectively teaches away from making the proposed combination. This provides a second, independent reason to reconsider and withdraw the present rejection.

Conclusion

The Applicant respectfully requests reconsideration in light of the submitted remarks and amendments. A Notice of Allowance is earnestly solicited. If any matter relating to this case needs to be discussed, please call our office at (408) 297-9733 between 9 a.m. and 5 p.m. Pacific time.

Respectfully submitted,

CERTIFICATE OF MAILING

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being transmitted via the Office electronic filing system in accordance with § 1.6(a)(4) on the date shown below.

Signed: *Sally Azevedo*
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